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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/882,197	06/25/1997	PAUL GREER	42390.P4072	3875

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 08/08/2003

45

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/882,197

Applicant(s)

GREER ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6,9-13 and 17-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6,9-13 and 17-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Final Office action is responsive to Applicant's amendment filed July 21, 2003.

Claims 3, 9, and 17 have been amended.

Claims 3-6, 9-13, and 17-57 are pending.

2. The previously pending rejection under 35 U.S.C. § 112, 1st paragraph is withdrawn in response to Applicant's amendment of the claims.

Response to Arguments

3. Applicant's arguments filed July 21, 2003 have been fully considered but they are not persuasive.

Applicant argues:

Applicant's amended independent claims 3, 9, and 17 recite the use of an "agent," as is typically used in communication network applications, wherein the "agent" is a program that performs information gathering and/or processing tasks in the background. Background processes are typically defined as processes operating in the background that cannot accept interactive input from a user, but can access data stored on a disk and write data to the video display, etc. Attached hereto as Exhibit A are definitions for the terms "agent" and "background" from the Webopedia dictionary, which is an authoritative source for computer terms accessible from the Internet. Further, this definition of the term "agent" corresponds to the description of the agent, and the use of the agent as disclosed in Applicant's specification.

In fact, Applicant respectfully submits that O'Toole teaches the opposite of an agent and *teaches away* from Applicant's amended independent claims 3, 9, and 17. In

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contrast to Applicant's claims, O'Toole uses an interactive smart digital offer object to allow the user to be interactively asked whether the user wishes to reveal certain user information and to further ask the user if the user wishes to accept an offer of a product or service, which the user can then interactively accept or decline. The interactive smart digital offer object is not an agent as recited in all of Applicant's amended independent claims, and in fact *teaches away* from Applicant's claimed invention. (Page 12 of Applicant's Response)

The Examiner respectfully disagrees. First, in response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein the "agent" is a program that performs information gathering and/or processing tasks in the background and wherein background processes are defined as processes operating in the background that cannot accept interactive input from a user, but can access data stored on a disk and write data to the video display, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While Applicant cites definitions from Webopedia, the Examiner also points out that the Microsoft Press Computer Dictionary (3rd ed.) defines an "agent" as "a program that searches through archives or other repositories of information on a topic specified by the user. Agents of this sort are used most often on the Internet and are generally dedicated to searching a single type of information repository, such as postings on Usenet groups" (see second definition). (This definition of "agent" from the Microsoft Press Computer Dictionary (3rd ed.) was originally provided to the Applicant in

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Final Office action, Paper No. 39 (mailed February 13, 2003).) Applicant's specification fails to expressly define Applicant's intended interpretation of the term "agent."

Therefore, the Examiner has justifiably imparted a reasonable interpretation of the term "agent" when applying the art rejection. Second, it is common knowledge that an agent is programmed to function autonomously, i.e., it "automatically" performs functions which it is programmed to carry out. More specifically, Examiner has explained in the art rejection that O'Toole's "offer objects" are agents; they are programmed to automatically and autonomously perform specified functions, including searching for information (e.g., coupons, product offers, etc.) likely to be of interest to a user.

Furthermore, it should be noted that O'Toole's agents do gather information and process tasks in the background according to the definition of "agent" as set forth in the Webopedia dictionary. As admitted by Applicant in the arguments, O'Toole's offer objects merely interact with the user when requesting the user's permission to reveal certain user information and/or inquiring about the user's willingness to accept an offer of a product or service. However, the offer object still performs its initial search for the product and service offers in the background. In other words, the offer object autonomously, i.e., on its own/without direct user intervention, gathers this information before presenting the pertinent results (i.e., offers) to the user. Therefore, the Examiner's interpretation of an "agent" (as set forth in the art rejection) indeed conforms to well-known and commonly accepted interpretations of the term "agent," such as those found in Microsoft Press Computer Dictionary (3rd ed.) and the Webopedia dictionary.

In summary, Applicant's arguments are found to be non-persuasive.

The following rejection addresses the claims as they presently stand.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-6, 9-13, and 17-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Toole, Jr. et al. (U.S. Patent No. 6,279,112 B1) in view of Davis et al. (U.S. Patent No. 5,796,952).

O'Toole discloses a system comprising:

[Claim 3] a target computer to receive a content (Figs. 1, 3 – The client computer is the target computer); and

a content provider coupled to the target computer via a network to transmit the content (Figs. 1, 3 – The servers are content providers), the content provider comprising:

a user rule page containing information automatically obtained from the target computer by a first agent, the first agent having a triggering program to filter information and to determine whether the information is relevant to the user rule page (col. 7, line 24 through col. 8, line 4 – The smart digital offer object functions as the claimed "first agent." Profile information, i.e., "a user rule page," received from the client computer is

sent to trusted servers. This profile information is information requested by, i.e., information deemed significant to, the trusted servers; therefore, O'Toole's smart digital offer object functions as the claimed "first agent having a triggering program to filter information and to determine whether the information is significant"); and

a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer, the rule stored in form of a condition-action pair (col. 10, lines 18-24 – Customizing "client-specific sales offers and coupons" sent by a server to a client computer based on the profile received from the client computer is by definition controlled by a set of rules. This is how the server automatically determines which offers and coupons to send to which client. Further, all decisions made in a computer system are based on condition pairs. For example, if A is true, then perform B. If the client has a history of purchasing computer parts, send him/her an advertisement and/or coupon to purchase a DVD drive. O'Toole's collection of rules for customizing targeted information based on a client's profile is equivalent to the claimed "rulebook...based on the user rule page");

[Claim 5] wherein the first agent uses an internet programming language (col. 7, lines 26-29 – O'Toole's smart digital offer object may be programmed as an Active X applet. Active X is known in the art to be useful for developing interactive content for the World Wide Web, i.e., the internet);

[Claim 6] wherein the rule page comprises at least one of a hardware profile indicating hardware capabilities of the target computer, a software profile indicating software used by the target computer, and a user profile including dynamic information

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related to a user using the target computer (col. 7, lines 38-43; col. 8, lines 1-4; col. 9, lines 18-28 – O'Toole's smart digital offer object may track "dynamic information related to a user using the target computer," such as the user's purchasing history);

[Claim 21] further comprising a second agent to update information in the user rule page rule directs the content in a database and provides a rule page corresponding to the target computer (col. 7, lines 24-43 – A smart digital offer object is retrieved with each "document of web-based information" and each additional object can update the user's profile, i.e., "user rule page");

[Claim 41] wherein the content is transmitted in an internet protocol format (col. 10, lines 18-21);

[Claim 43] further comprising a second agent to update information in the rule page (col. 7, lines 24-43 – A smart digital offer object is retrieved with each "document of web-based information" and each additional object can update the user's profile, i.e., "user rule page");

[Claim 46] wherein the first agent is an object code for a control residing on a web page (col. 7, lines 24-43 -- A smart digital offer object, e.g., written in Active X, is retrieved with each "document of web-based information" and then activated at the client computer);

[Claim 47] wherein the control is transmitted with the web page while a dormant object resides on a server (col. 7, lines 24-43 -- A smart digital offer object, e.g., written in Active X, remains dormant on the server until it is retrieved with a "document of web-based information" and then activated at the client computer);

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[Claim 48] wherein the target computer communicates with additional content providers, and wherein the target computer maintains several provider rule pages of the additional content providers (col. 7, lines 22-62 – The “additional content providers” are equivalent to O’Toole’s multiple trusted servers, each of which is separately authorized by the client’s avatar to have access to requested client information, which is then used to create a respective user profile, i.e., “rule page,” stored by each of the authorized trusted servers);

[Claim 49] wherein each provider rule page includes information from at least one of the additional content providers (col. 7, lines 22-62 – The “additional content providers” are equivalent to O’Toole’s multiple trusted servers, each of which is separately authorized by the client’s avatar to have access to requested client information, which is then used to create a respective user profile, i.e., “rule page,” stored by each of the authorized trusted servers).

Regarding claims 3, 4, 24-26, and 28, O’Toole discloses the use of a “channel object” to set up an asynchronous communication service for providing information to a client computer via a broadcast, satellite feed, internet, cable, or multicast channel (col. 4, lines 20-50; col. 5, lines 4-22; col. 6, lines 32-39). In order to successfully set up a communication channel between a client and server, the two must be utilizing hardware and software compatible with the particular type of communication used (e.g., broadcast, satellite feed, internet, cable, or multicast channel). O’Toole does not explicitly disclose how this confirmation of compatibility between the client and server’s

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communication hardware and software is established; however, Davis teaches the monitoring of client activity in order to create a client profile that is used to target content, such as an ad, to a user (col. 4, lines 24-27). More specifically, Davis discloses a tracking system that comprises agents, such as JAVA applets or those written in Active X, in order to profile user information (col. 10, lines 50-57). Davis states that the following types of information can be obtained from a client computer:

...When the client leaves the Web page (S307), the tracking program calculates the amount of time the user has interacted with and displayed the Web page and sends this information to a server. Other available client information, such as the network ID and client ID, or so-called 'Cookie' of the client, is also sent to the server (S308). If desired, other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer. (Col. 9, lines 35-45)

Davis teaches the ability to use an agent to obtain data regarding hardware characteristics of a target computer (as per claim 3). Further, Official Notice is taken that it is old and well-known in the art of computers that modem speed, processor type, amount of memory available, processor clock speed, and computer memory usage are commonly used to define the hardware characteristics of a computer (as per claims 4 and 24). Also, Official Notice is taken that it is old and well-known in the art of computers to assess the software profile, including data regarding a software package and memory usage, of a computer (as per claim 25). All of this information regarding hardware and software characteristics of a computer is important when deciding which communication protocols to establish, especially when compatibility of communication

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protocols between a server and client is being assessed (as would be important to O'Toole for the reasons discussed above). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with O'Toole a condition in the condition-action pair being a hardware characteristic, including modem speed, processor type, amount of memory available, processor clock speed, and computer memory usage, of the target computer to then use the rule to match content with the hardware characteristics of the target computer (as per claims 3, 4, 24, 28) and to incorporate with O'Toole the ability to gather software profile information, including that of a software package and memory usage of the target computer (as per claim 25) in order to help ensure that O'Toole's channel objects are transmitting content, such as advertisements, to client computers using both a communication protocol that is compatible with the server and respective client computer as well as an amount of information that can be handled by the respective client computer.

Regarding claim 26, O'Toole does not explicitly teach the profiling of the web sites visited and time spent at each by a user; however, Davis makes up for this deficiency, as discussed above and in col. 9, lines 35-38 and col. 13, lines 47-62. Davis uses this information to more effectively "target an ad banner based upon the diverse interests of respective users" (col. 13, lines 60-62). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable O'Toole to profile information regarding the web sites visited and time spent at each by a user (as taught by Davis) in order to assist O'Toole

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in more effectively targeting content, such as advertisements, that may be of interest to each respective user.

[Claim 29] O'Toole teaches the transmission of advertisements to client computers (col. 10, lines 18-21); however, he fails to explicitly disclose that the advertisements may be advertisement banners *per se*. Davis discloses the targeting of advertisement banners based on a user's profile (col. 13, lines 57-62). Advertisement banners typically span a web page and are therefore especially useful in drawing a customer's attention to an ad. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt O'Toole to transmit targeted advertisement banners to its users (as taught by Davis) in order to provide web-based ads which are especially useful in drawing a user's attention to the advertised product or service, which is targeted to a user based on his/her profile.

[Claims 9-13, 30, 31, 33-35, 37-39, 44, and 50-53] Claims 9-13, 30, 31, 33-35, 37-39, 44, and 50-53 recite limitations already addressed by the rejection of claims 3-6, 21, 24-26, 28, 29, 41, 43, and 46-49 above; therefore, the same rejection applies.

Furthermore, as per claim 31, O'Toole's customer profiles are dynamic; therefore, they are presumably updated when customer data changes (col. 7, line 38 through col. 8, line 4; col. 9, lines 15-54; col. 10, lines 4-38). In other words, updating customer profile data comprises the steps of "inserting new data into the rule page" and "removing old data from the rule page." For example, the presence of coupons on a client computer is

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detected as part of the profile, i.e., rule page, information (col. 7, lines 40-43); therefore, once a coupon is used, it is then deleted from the list of active coupons on the client computer. Upon updating a profile, this change would be updated as well, presumably by "inserting new data into the rule page" and "removing old data from the rule page" (as per claim 31).

[Claims 17-20, 22, 23, 27, 32, 36, 40, 42, 45, and 54-57] Claims 17-20, 22, 23, 27, 32, 36, 40, 42, 45, and 54-57 recite limitations already addressed by the rejection of claims 3-6, 21, 24-26, 28, 29, 41, 43, and 46-49 above; therefore, the same rejection applies.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:


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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.


Susanna M. Diaz
Primary Examiner
Art Unit 3623
August 7, 2003